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| 10/706,710 | 11/12/2003 | Herman Scherling | 450100-04469.1 | 8587 |
| 7590 09/22/2008 FROMMER LAWRENCE & HAUG LLP 10TH FLOOR 745 FIFTH AVENUE NEW YORK, NY 10151 | | | EXAMINER | |
| | | | MISLEH, JUSTIN P | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/706,710 | Applicant(s) SCHERLING, HERMAN |
| | Examiner JUSTIN P. MISLEH | Art Unit 2622 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 February 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 2 - 22 and 28 - 50 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2 - 22 and 28 - 50 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/213,434.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informed Patent Application
 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 26, 2008 have been fully considered but they are not persuasive.

Claim to Priority

2. Applicant argues, "In response to the comments regarding the claim to priority, Applicant submits that the present application is a Continuation of U.S. Serial No. 09/213,434, now U.S. Patent No. 6,850,279, filed December 17, 1998, which is derived from PCT/DK97/00261, filed June 17, 1997, which claims the benefit of Denmark 0676/96 filed June 18, 1996. Therefore, the present application has an effective filing date of June 18, 1996."

3. The Examiner disagrees with Applicant's position. The Declaration for parent application 09/213,434, filed December 17, 1998, indicates a claim for benefit under 35 USC 119(e) for the provisional application 60/043,260 and a claim for priority under 35 USC 119(a-d and f) for Danish application 0676/96. The corrected Declaration for 09/213,434, filed October 14, 2003, indicates a claim for priority under 35 USC 119(a-d and f) for Danish application 0676/96 and a new claim for priority under 35 USC 119(a-d and f) for International application PCT/DK97/00261. However, as previously stated, the December 17, 1998 filing date for 09/213,434 is more than one year subsequent to the filing date of the provisional application (April 17, 1997), the filing date of the Danish application (June 18, 1996), and the filing date of the International application (June 17, 1997). Because the statutory requirements for these claims have NOT been met, benefit/priority will not be granted.

Double Patenting

4. Applicant states, “In response to the Double Patenting rejection, Applicant submits herewith a Terminal Disclaimer and fee, thereby obviating the Double Patenting rejection.”

5. The Examiner submits no Terminal Disclaimer has been filed. Thus the rejection stands.

Prior Art

6. Applicant argues, “Ogura fails to teach or suggest a lens in the back lens group, which is closest to the front lens group, is positioned at the cut off portion of front lens group ... the Office Action relies on Ogura to describe a prism-like optical member G2 as the back lens group ... the back lens group 22 is a collective member made out of four elements, and the first lens on the left side, which is closest to the lens group 21, is positioned at the cut off portion of front lens group 21, so that the thin-model device is realized.”

7. The Examiner respectfully disagrees with Applicant’s position. First, the Examiner relied on optical member G3 as the back lens group and not member G2 as alleged above. Second, the claims do not require, explicitly or implicitly, where either the front lens group or second lens group requires a “collective member made out of four elements”. However, the fact that light is bent within each of member G1 and G3 indicates that each member is complex element involving a group of optical-acting members. Third, the optical member G3 as whole is adjacent to optical member G1 and the two cut off portions of G1. Therefore, each of the optical-acting members within G3 is positioned at the cut off portion of G1. For these reasons, the rejection will be maintained.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

10. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. **Claims 2 – 22 and 28 – 50** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **Claims 1 – 22** of U.S. Patent No. 6,850,279 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

12. **Claims 28 and 29** (present application) are each broader and fully encompassed in nearly all respects by **Claim 1** (referenced patent). All claim language of each of Claims 28 and 29 is contained within Claim 1; however, Claims 28 and 29 each further require “wherein a lens in the back lens group, which is closest to the front lens group, is positioned at the cut off portion of front lens group” and “wherein at least one lens adjacent to said reflective element is a non-rotary symmetrical lens.”

On the other hand, Ogura et al. also disclose, as shown in figure 1, an optical image recording system for electric recording of optical information, the optical image recording system comprising: a lens system (figure 1 shows a photographing optical system) and a body (moving bases 3 and 4); a lens system comprises: a front lens group (G1) having a first optical axis (the optical axis emerging through opening 1a and reflecting off of an internal reflecting surface of G1 is considered the first optical axis); a back lens group (G3) having a second optical axis (the optical axis passing through G3 is considered the second optical axis); and a reflective element (internal reflecting surface of G1) folding said first optical axis into said second optical axis in an angle of less than 180 degrees (The first optical axis is folded five times – three times in optical element G1 and two times in optical element G2. Each axis is folded 90 degrees.). Ogura et al. further teach wherein at least one lens adjacent (G2) to said reflective element

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(internal reflecting surface of G1) is a non-rotary symmetrical lens (G2 is does not rotate and is symmetrical).

Furthermore, the claims do not require, explicitly or implicitly, where either the front lens group or second lens group requires a “collective member made out of four elements”.

However, the fact that light is bent within each of member G1 and G3 indicates that each member is complex element involving a group of optical-acting members. Additionally, the optical member G3 as whole is adjacent to optical member G1 and the two cut off portions of G1. Therefore, each of the optical-acting members within G3 is positioned at the cut off portion of G1.

Hence, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included wherein at least one lens adjacent to said reflective element is a non-rotary symmetrical lens (as taught by Ogura et al.) in the optical image recording system (disclosed by Scherling) for the advantage providing an optical system for a photographing apparatus which as excellent assembly performance and attain a decrease in thickness (see Ogura et al., Abstract).

13. **Claims 2 – 22 and 30 – 50** (present application) are each identical to **Claims 2 – 22** (referenced patent).

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. **Claims 2 – 7, 11 – 19, 22, 28 – 35, 39 – 47, and 50** are rejected under 35 U.S.C. 102(c) as being anticipated by Ogura et al. (US 6,498,624 B1).

16. For **Claims 29 and 28**, Ogura et al. disclose, as shown in figure 1, an optical image recording system for electric recording of optical information, the optical image recording system comprising:

a lens system (figure 1 shows a photographing optical system) and a body (moving bases 3 and 4); a lens system comprises:

a front lens group (G1) having a first optical axis (the optical axis emerging through opening 1a and reflecting off of an internal reflecting surface of G1 is considered the first optical axis);

a back lens group (G3) having a second optical axis (the optical axis passing through G3 is considered the second optical axis);

wherein a lens in the back lens group, which is closest to the front lens group, is positioned at the cut off portion of front lens group (see explanation paragraph below); and

a reflective element (internal reflecting surface of G1) folding said first optical axis into said second optical axis in an angle of less than 180 degrees (The first optical axis is folded five times – three times in optical element G1 and two times in optical element G2. Each axis is folded 90 degrees.);

wherein at least one lens adjacent (G2) to said reflective element (internal reflecting surface of G1) is a non-rotary symmetrical lens (G2 is does not rotate and is symmetrical).

The Examiner notes the claims do not require, explicitly or implicitly, where either the front lens group or second lens group requires a “collective member made out of four elements”. However, the fact that light is bent within each of member G1 and G3 indicates that each member is complex element involving a group of optical-acting members. Additionally, the optical member G3 as whole is adjacent to optical member G1 and the two cut off portions of G1. Therefore, each of the optical-acting members within G3 is positioned at the cut off portion of G1.

17. As for **Claims 30 and 2**, Ogura et al. disclose, as shown in figure 1, wherein the lens system comprises an additional reflective element (G4) folding the second optical axis (the optical axis passing through G3 is considered the second optical axis) into the optical axis of the image recording device (2 – see figure 8).

18. As for **Claims 31 and 3**, Ogura et al. disclose, as shown in figure 1, wherein the first optical axis and the second optical axis form an angle equal to or less than 90 degrees (as clearly shown in figure 1, the first optical axis, as defined by the Examiner above, is perpendicular to the second optical axis, as defined by the Examiner).

19. As for **Claims 32 and 4**, Ogura et al. disclose, as shown in figure 1, wherein the second optical axis and an optical axis of an image recording device form an angle equal to or less than 90 degrees (as clearly shown in figure 1, the second optical axis, as defined by the Examiner above, is perpendicular to the image recording optical axis, as defined by the Examiner).

20. As for **Claims 33, 34, 5, and 6**, Ogura et al. disclose, as shown in figure 1, wherein the first optical axis and an optical axis of an image recording device are substantially in the same plane and are substantially parallel (In the perspective shown in figure 1, the first optical axis and

the image recording optical axis are vertical optical axes and are parallel to each other. Since the claim language does not provide a point of reference or origin through the claimed "plane" passes, the claim language encompasses an infinite number of planes – i.e., any plane formed between two points. Thus, when the photographing optical system of figure 1 is viewed from top side perspective, a plane would connect the point representing the first optical axis and the point representing the image recording optical axis.) .

21. As for **Claims 35 and 7**, Ogura et al. disclose, as shown in figure 1, wherein an image recording device is a charge coupled device (As shown in figure 31 and as stated in column 1, lines 59 – 62, the invention directed to all solid-state image sensing devices including CCDs).
22. As for **Claims 39, 40, 11, and 12**, Ogura et al. disclose, as shown in figure 1, wherein the front lens group (G1) and the reflective element (internal reflecting surface of G1) consist of a prism, where an additional reflective element (G2) consists of a prism.
23. As for **Claims 41 and 13**, Ogura et al. disclose, as shown in figure 1, wherein an aperture stop (opening 1C is an aperture upon which light passes through) of the lens system is determined by a stop (the image sensor is positioned behind the aperture 1C) placed after the reflective element (internal reflecting surface of G1) and in the back lens group (G3).
24. As for **Claims 42 and 14**, Ogura et al. disclose, as shown in figure 12, wherein said body further comprises means for storing, transferring and receiving electronic signals of optical information and other information to and from an external device (637).
25. As for **Claims 43 and 15**, Ogura et al. disclose, as shown in figure 12, wherein the means for transferring and receiving electronic signals comprise a connector device having a databus interface (608, 610, 612, and 613).

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26. As for **Claims 44 and 16**, Ogura et al. disclose, as shown in figure 12, wherein the connector device is accommodated in an end face of said body (613 is a digital output for outputting outside the apparatus; see column 14, lines 43 – 55).

27. As for **Claims 45 and 17**, Ogura et al. disclose, as shown in figure 12, wherein the storage means for storing the electronic signals consist of an exchangeable memory (The fact that an external storage medium can be connected to the output 613 indicates that the external storage medium is exchangeable; see column 14, lines 43 - 55).

28. As for **Claims 46 and 18**, Ogura et al. disclose, as shown in figure 12, wherein the body further comprises means for storing electronic signals of control information for controlling the operation of the external device (The image signals output to either display 609 or digital output 613 control those devices, respectively; see column 14, lines 43- 55).

29. As for **Claims 47 and 19**, Ogura et al. disclose, as shown in figure 12, which further comprises means for loading the control information into the external device (The image signals output to either display 609 or digital output 613 control those devices, respectively; see column 14, lines 43- 55).

30. As for **Claims 50 and 22**, Ogura et al. disclose, as shown in figure 1, wherein said body (moving bases 3 and 4) further comprises guiding means (rail portions 13, . . . , 16) for its guidance in a slot.

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. **Claims 20, 21, 48, and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura et al. (US 6,498,624 B1).

33. As for **Claims 48, 49, 20, and 21**, while Ogura et al. disclose, as shown in figure 12, wherein said body further comprises means for storing, transferring and receiving electronic signals of optical information and other information to and from an external device (637); Ogura et al. do not specify wherein the means for transferring electronic signals comprise a wireless transmitter of analogue and/or digital transmission or wherein the means for receiving electronic signals comprises a wireless receiver of analog and/or digital transmission.

However, Official Notice (MPEP § 2144.03) is taken that both the concepts and advantages of providing a wireless transmitter/receiver for analogue and/or digital transmission are well known and expected in the art. At the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included a wireless transmitter/receiver for analogue and/or digital transmission in the system disclosed by Ogura et al. for the advantage *transferring image data to remote locations*.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Sinh Tran can be reached on 571.272.7564. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Justin P. Misleh/
Primary Examiner
Group Art Unit 2622
September 23, 2008